

**REMARKS**

Reconsideration and withdrawal of the requirement for election of species and rejections of the application respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

5      **I. STATUS OF CLAIMS AND FORMAL MATTERS**

The applicants thank the Examiner for acknowledging allowable subject matter if the objections and rejections under 35 U.S.C. §112 were adequately addressed and also for meeting with the applicants' representative, Howard C. Lee, on 14 September 2006 to discuss the claims.

With the entry of this amendment, claims 1, 13-17, 22-30 and 35-38 will be pending in  
10 this application. Claims 8 and 31-34 have been cancelled and claims 1, 15, and 22-30 have been amended to address the Examiner's objections/rejections of the claims and the issues addressed during the 14 September interview. New claims 35-38 have been added to claim narrower aspects of claims 1 and 26. The applicants reserve the right to further pursue the scope of the originally filed claims in a continuing application.

15      No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103  
20 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

**II. THE OBJECTIONS TO THE SPECIFICATION HAS BEEN OVERCOME**

A statement claiming priority to DE 199 12 636 has been inserted.

With respect to the specific informalities which provided the basis for the objection to  
25 claims 1, 15, 22, 23 and 26-28, these have been addressed as follows:

- (1)      The extra "or" has been deleted from claim 1 (see page 4, last line and page 6, line 5 of this amendment).
- (2)      The Examiner is correct that this was intended to read as ---P(=O)(R<sup>15</sup>)(OR<sup>14</sup>)--- (see page 6, line 6 of this amendment; support can be found, e.g., on page 19, line 28 of the specification)

- (3) Each occurrence of “substituted” has been amended to read ---is substituted--- as suggested by the Examiner.
- (4) The applicants have added to conjunction ---or--- as suggested (see page 6, line 5 of this amendment).
- 5 (5) The applicants have adopted the Examiner’s suggestion to use rounded brackets (see page 6, line 13 of this amendment).
- (6) The misspelling in claim 15 has been corrected.
- (7) The extraneous marks and typographical errors have been corrected in claim 22.
- (8) Claims 31 and 33 have been cancelled rendering these objections moot.
- 10 (At the time of this submission, a clean copy of the original specification and claims has not been obtained, but is expected to be filed soon)

### **III. THE 35 U.S.C. 112, 1st PARAGRAPH REJECTION HAS BEEN OVERCOME**

Claims 1, 8, 13-17 and 22-34 were rejected as allegedly failing to describe and enable the scope of the invention claimed. While the applicants disagree with the positions taken by the Examiner, the claims have been amended which narrow the scope of the claims which is believed to render this rejection moot. The applicants reserve the right to pursue the scope of the originally filed claims in a continuing application.

### **IV. THE 35 U.S.C. 112, 2<sup>nd</sup> PARAGRAPH REJECTION HAS BEEN OVERCOME**

Claims 1, 8, 22-31 and 33 were rejected as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as their invention.

Note: The applicants have complied with the Examiner’s request to use parallel language for the definition of (a) and (b) for variable E.

25 During the interview, it appeared that the rejection based on inoperative embodiments “like SF<sub>5</sub>” was not based on the literal existence of a specific moiety (see e.g. U.S. Patent 7,094,365 for a compound with an SF<sub>5</sub> moiety), but the scope of the atom which could be linked to the described moiety, i.e. -N-R<sup>O</sup>. In order to simplify the amendment, the definition of R<sup>O</sup> has 30 been amended to describe different scopes depending on whether R<sup>O</sup> is bonded to a nitrogen atom or a carbon atom.

In addition, the claims had previously been amended to clearly indicate that the method of use is for providing herbicidal effects in plants and as such the issue regarding the amount of direction provided for use in mammals was rendered moot.

With regard to the Examiner's other concern that claim 22 did not encompass certain examples such as Example 12-1 (page 89 of the specification) disclosed by the applicants, the applicants note that previous claim 22 was missing the definition of L\* to establish that the heterocycles encompassed within the definition of claim 1 could be substituted with a hydroxyl moiety (e.g. -OR<sup>4</sup> where R<sup>4</sup> is hydrogen). This limitation is supported, e.g., by the definition of claim 1 and the description on page 4, lines 3-14 of the specification. Claims 1 and 22 have been further amended to recite "linking bridge moiety" in line 1 of the definition of the variable G in order to establish antecedent basis for the use of the term in (b).

Although the applicants' believe that the claims as originally filed were adequately described and enabled, with the amendments to the claims, the scope of the claims has been narrowed and it is believed that the current scope of the claims would not require undue experimentation by the applicants as the applicants have provided a description of the structural formula of the compound necessary to practice the invention and have provided some examples for the applicants as guidance.

#### **V. THE 35 U.S.C. 112, 4<sup>th</sup> PARAGRAPH REJECTION HAS BEEN OVERCOME**

This rejection has been rendered moot by the cancellation of claims 32 and 34.

#### **VI. RESPONSE TO REQUEST FOR INFORMATION UNDER RULE 1.105**

The exception language arose because the compound deaminoformycin, i.e. the compound of formula (I) in which A = CH, D = C, E = NH and G-L =  $\beta$ -D-ribofuranosyl, was known in the art. This was discussed in the specification from page 6, line 27 through page 7, line 10; reference was also made to articles by Milne et al., *J. Chem. Soc. Perkin Trans. I*, 2677-2681 (1972) and Watanabe et al., *J. Antibiotic Ser. A*, 19: 93-96 (1966). Copies of these references were provided with the Information Disclosure Statement filed on 19 July 2000 and was initialed as being considered by the Examiner on 2 September 2002.

**CONCLUSION**

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the  
5 Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP

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By:

Howard C. Lee  
Marilyn M. Brogan Howard C. Lee  
Reg. No. 31,233 Reg. No. 48,104  
Telephone: (212) 588-0800  
Facsimile: (212) 588-0500